

REMARKS

Claims 1-17 are pending in the present Application. No claims have been canceled, Claim 1 has been amended, no claims have been added, and Claims 14-17 remain withdrawn, leaving Claims 1-13 for consideration upon entry of the present Amendment.

Amendments to Claims

Claim 1 has been amended to recite that the chain transfer agent is added alone “when a conversion ratio of an outermost layer is 60 to 95% after completing the preparation of the outermost layer of the shell polymers to select a gel content and a molecular weight of the outermost layer of the latex.” Support for this amendment can be found in the Specification at least on p. 14, line 7 and p. 15, lines 5-17.

Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-13 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent Application Publication No. 2003/105222 (“Choi”) in view of U.S. Patent No. 3,970,629 (“Izaki”). Applicants respectfully traverse this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, or knowledge generally available in the art at the time of the invention, must provide some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). “A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). To find obviousness, the Examiner must “identify a reason that would have prompted a person of ordinary skill in the art in the relevant field to combine the elements in the way the claimed new invention does.” *Id.*

Claim 1, as amended, claims:

1) the manufacture of a core with multiple shells, which is in the second step among the steps of manufacture of latexes of the present invention is done through polymerization by

inputting a new monomer mixture when the conversion ratio of monomers to polymers is 55 to 95%. See the Specification on p. 14, line 7 to p. 15, lines 5-17;

2) After an outermost layer of the multiple shell polymerization step is completed, the chain transfer agent alone is added when the conversion ratio of an outermost layer is 60 to 95% to adjust the gel content and molecular weight of the outermost layer of the latex. See Specification, p. 14, line 7 and p. 15, lines 5-17.

As to the rejection over Choi in view of Izaki, the Examiner states that Choi teaches a method of making a styrene-butadiene latex for coating paper comprising preparing a styrene-butadiene core, and forming coatings around the core by emulsion polymerization. Choi, [0023], [0027]-[0029]. Choi also teaches that gel content and molecular weight of the latex is adjusted by including a chain transfer agent. Choi, [0049]. Izaki discloses that the chain transfer agent is included to reduce gel content to 60% or less, where “[t]he chain transfer agent may be used alone or in admixture and also added simultaneously or continuously. The agent may be employed as a mixture with each of the monomers. Col. 3, lines 51 to Col. 4, line 8. Applicants understand this to mean that one chain transfer agent or a mixture of such agents may be used, and that these agents are added “simultaneously”, i.e., at the same time as other components (assuming a single charge or a mixture of all components) or “continuously”, i.e. in a continuous, separate feed. Col. 4, lines 4-7. Izaki also discloses that the amount of chain transfer agent is “one of the most important key factors to reduce the gel content of the copolymer” and that “a larger amount of the chain transfer agent may result in a lower gel content.” Col. 4, lines 4-12.

Izaki further states that “the gel content is also influenced by various other factors such as *polymerization temperature, conversion, monomer charge technique and the like*, the amount of the chain transfer agent may be decided appropriately in each case by taking the other factors into consideration. For instance, the use of about 0.6 to 0.8 part by weight or more of a chain transfer agent (e.g. dodecyl mercaptan) per 100 parts by weight of the total amount of the monomers is proper in case of the polymerization being effected at a temperature of about 50 to 70 °C in a conversion of around 95 to 100%. Further, for instance, the use of about 0.1 to 0.2 part by weight of such chain transfer agent may be appropriate in case of the polymerization being carried out at a temperature of about -5 to 10 °C in a conversion of around 60%. When the temperature is higher, the amount of the chain transfer

agent may be generally increased. When the conversion is lower, the amount of the chain transfer agent may be usually decreased.” Col. 4, lines 13-42.

However, the Examiner does not identify in the cited references Choi or Izaki or in the art in general the timing of the addition of chain transfer agent (i.e., after an outermost layer of the multiple shell polymerization step is completed), which is a critical feature of the present invention.

Izaki discloses that the chain transfer agent may be added alone, but does not teach when the chain transfer agent is added. Izaki states that “[t]he *chain transfer agent may be used alone or in admixture and also added simultaneously or continuously. The agent may be employed as a mixture with each of the monomers.*” Izaki, Col. 4, lines 4 to 8.

In the office action, it is indicated that Izaki teaches adding the chain transfer agent to the copolymer (see, e.g., Col. 3, line 51 to Col. 4, line 8). However, Izaki does not disclose the timing (i.e., at what point in the process) for adding the chain transfer agent, or that the as well as the addition to the copolymer.

Referring again to Col. 3, line 51 to Col. 4, line 8 of Izaki:

“In the production of the synthetic copolymer latex according to the present invention, there is used a chain transfer agent which not only plays the role of regulating the molecular weight of the **synthetic copolymer** but also functions to prevent the formation of a three-dimensional structure between the double bonds present in the starting monomers and remaining in the produced polymer during the polymerization. The use of such a chain transfer agent can adjust the gel content of the **synthetic copolymer**, which may provide a paper coating composition excellent in its blister-preventing and water-resistant properties during web off-set printing processes. Examples of the chain transfer agent are acrolein, methacrolein, allyl alcohol, 2-ethyl-hexyl thioglycolate, mercaptans (e.g. octyl mercaptan, n-dodecyl mercaptan, t-dodecyl mercaptan, n-hexadecyl mercaptan, mixed t-mercaptans), thiuram type sulfides (e.g. tetraethylthiuram sulfide, dipentamethylene thiuram hexasulfide), The chain transfer agent may be used alone or in admixture and also added simultaneously or continuously. The agent may be employed as a mixture with each of the monomers.”

Though, *arguendo*, Izaki discloses that the chain transfer agent is added to the copolymer, there is no suggestion or incentive in Izaki that the chain transfer agent *alone* is

added *after an outermost layer of the multiple shell polymerization step is completed*, as claimed in instant Claim 1. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989) (“Although the Commissioner suggests that [the structure in the primary art reference] could readily be modified to form the [claimed] structure, ‘[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification’”) (citation omitted); *In re Stencel*, 828 F.2d 751, 755, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987) (obviousness cannot be established “by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion that the combination be made”). There is therefore no teaching or suggestion to add the chain transfer agent at the time of forming the outermost shell, and hence no suggestion to combine elements of the prior art or modify the cited art to produce the present invention. The present invention is thus nonobvious.

The effect of adding the chain transfer agent after an *outermost layer* of the multiple shell polymerization step is completed is further demonstrated by the instant examples. Even where a *prima facie* case of obviousness exists, obviousness may be rebutted by a showing of “unexpected results”, i.e., comparative test data showing that the claimed invention possesses unexpectedly improved properties, or properties that the prior art does not have. *In re Dillon*, 919 F.2d 688, 692-93, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990). The results must be of both statistical and practical significance. *Ex parte C*, 27 U.S.P.Q.2d 1492, 1497 (Bd. Pat. App. & Int. 1993).

Comparative Examples 3 to 6 (see Specification, Table 4, p. 25), in which the gel content and molecular weight are adjusted during the manufacture of the shells by inputting singly (i.e., by only adding) a chain transfer agent after coating the second shell in the process of coating the triple shells, exhibit somewhat but not significantly improved ink-drying speed and air permeability physical properties relative to those of Comparative Example 2 in which there was no addition of chain transfer agent alone. However, in Examples 6 to 9 in which the gel content and molecular weight of the outermost layer are adjusted by adding singly a chain transfer agent after the manufacture of the last and third shell, significantly superior adhesive force as well as ink-drying speed and air permeability are obtained. Thus, the point in the process at which the chain transfer agent is added singly (after completing polymerization of multiple shells) has a significant effect on the physical properties of the

resultant core-multiple shell copolymer, and hence the timing of the addition is an important factor of the present invention. Choi and Izaki are silent as to this effect and provide no guidance that would lead one skilled in the art to the effect.

In the Office Action, Applicants respectfully note that the Examiner appears to have incorrectly interpreted the comparative examples, as these comparative examples do not preclude considering other factors when determining how much chain transfer agent to add. The comparative examples, it will be understood, provide comparative information for *when* the chain transfer agent alone is added, and not for *how much* chain transfer agent is added.

Accordingly, while Izaki discloses the use of chain transfer agent to adjust the gel content, Izaki specifically discloses and emphasizes only that the amount of chain transfer agent is critical, but is silent as to the timing of addition except that it may be added in admixture or continuously, neither of which statement would lead the skilled artisan to the unexpectedly improved physical properties obtained when the chain transfer agent is added at the polymerization of the outermost shell, as seen in the above instant examples.

Hence, there is no suggestion or incentive that would lead one of ordinary skill in the art at the time the invention was made i) to add monomers and a chain transfer agent onto the core latex when the conversion ratio of monomers to polymers in the first step is at 55 to 95% to polymerize monomers on the core latex through emulsion polymerization; and ii) to add the chain transfer agent alone when the conversion ratio of an outermost layer is 60 to 95% after the outermost layer of the multiple shell polymerization step is completed.

For these reasons at least, the method of styrene-butadiene latex claimed in Claim 1 is not obvious over Choi in view of Izaki. Reconsideration and withdrawal are respectfully requested.

Conclusion

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise,
please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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Date: June 2, 2011